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 Commissioner for Patents
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REMARKS

Claims 1-36 are pending in the application. Claims 1-36 are rejected.

The below remarks are organized according to the section headings of the Examiner's Detailed Action of Jun. 30, 2005.

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1. Section I

1.1. Claim Rejections - 35 U.S.C. § 101

In the Office Action with a date-mailed of Nov. 29, 2004, the Examiner rejected the claims under § 101 for having "no post-solution or final result." While applicants added claim limitations, that recite production of a result, in the Amendment filed May 27, 2005, the Examiner continues to maintain a rejection under § 101 "because the limitation is ambiguous as to who or whom is conducting the post-solution activity."

Applicants respectfully submit that they have no obligation to claim who or whom might use the results produced by their invention. 35 U.S.C. § 101 merely requires that an invention "produces a concrete, tangible and useful result" (emphasis added). There is no requirement for the claim to specify how such result may be used. For example, MPEP 2106 (IV) B 2 (b) ii) ("Computer-Related Processes Limited to a Practical Application in the Technological Arts") states:

A claim is limited to a practical application when the method, as claimed, produces a concrete, tangible and useful result; i.e., the method recites a step or act of producing something that is concrete, tangible and useful. See AT&T, 172 F.3d at 1358, 50 USPQ2d at 1452.

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For example, a computer process that simply calculates a mathematical algorithm that models noise is nonstatutory. However, a claimed process for digitally filtering noise employing the mathematical algorithm is statutory.

To support his rejection the Examiner quotes from the specification at page 44, lines 8 to 10. However, the quoted portion of the specification does not relate to the production of a final result, but refers to a step that is part of the process by which a result may be found. If the Examiner wishes to continue using this portion of the specification, as a basis for maintaining that certain claim limitations are ambiguous, applicants respectfully request that the Examiner specifically explain how such cited portion supports the rejection.

Further, applicants note that ambiguity, even if present in a claim, is not a proper basis for a § 101 rejection. If the Examiner wishes to continue using ambiguity as a basis for a § 101 rejection, applicants respectfully request the Examiner to identify specific legal authority for this.

1.2. Affidavits Under 37 CFR 1.132

The Examiner is incorrect in asserting that Declarations must be presented by the authors of Ho et al. who are not applicants of the present application. MPEP 2123.01, as cited by the Examiner in the present Office Action, states (emphasis added):

The rejection can also be overcome by submission of a specific declaration by the applicant establishing that the article is describing applicant's own work. *In re Katz*, 687 F.2d 450, 215 USPQ 14 (CCPA 1982). However, if there is evidence that the co-author has refused to disclaim inventorship and believes himself or herself to be an inventor, applicant's affidavit will not be enough to establish that applicant is the sole inventor and the rejection will stand. *Ex parte Kroger*, 219 USPQ 370 (Bd. Pat. App. & Int. 1982) (discussed below).

In *Ex parte Kroger*, 219 USPQ 370 (Bd. Pat. App. & Int. 1982), Kroger, Knaster and others were listed as authors on an article on photovoltaic power generation. The article was used to reject the claims of an application listing Kroger and Rod as inventors. Kroger and Rod submitted affidavits declaring themselves to be the inventors. The affidavits also states that Knaster merely carried out assignments and worked under the supervision and direction of Kroger. The Board stated that if this were the only evidence in the case, it

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would be established, under *In re Katz*, that Kroger and Rod were the only inventors. However, in this case, there was evidence that Knaster had refused to sign an affidavit disclaiming inventorship and Knaster had introduced evidence into the case in the form of a letter to the PTO in which he alleged that he was a co-inventor. The Board held that the evidence had not been fully developed enough to overcome the rejection.

With this Response, in accordance with *In re Katz*, an additional Declaration has been submitted, by each applicant, establishing the facts by which one can reach no other conclusion than that the non-applicant authors of Ho et al. only contributed unclaimed subject matter to Ho et al.

If the Examiner wishes to continue to require Declarations from the non-applicant authors of Ho et al., applicants respectfully request that the Examiner identify evidence, in accordance with *Ex parte Kroger*, to support such requirement.

The Examiner also stated that the affidavits need to answer "who is the primary inventor." Applicants respectfully submit that there is no basis in law, of which applicants are aware, for either defining the term "primary inventor" or for requiring that the affidavits presented identify such primary inventor. If the Examiner wishes to continue to require that applicants identify a primary inventor, applicants respectfully request that the Examiner specifically identify the legal definition and basis for such requirement.

The Examiner also cites to MPEP 716.02(e) and states that "[n]o evidence of technical detail related to the claims was presented." Applicants respectfully note that MPEP 716.02(e) is only applicable if a reference is prior art. Since the Declarations submitted remove Ho et al. as a prior art reference, the Examiner's arguments for anticipation and obviousness, based on the Ho et al. reference, have been obviated.

1.3. 35 U.S.C. § 102

The Examiner states: "The examiner is unclear why the attorney is mentioning in his arguments (on page 12 of 14) example 1 regarding 102(b)/102(e) references when a 102(a) reference was used in the rejection."

Applicants respectfully direct the Examiner's attention to the fact that the portion of page 12 of 14, referred to by the Examiner, is a quotation from MPEP 716.10. This portion of the MPEP is quoted because it is precisely relevant to the issue the Examiner has raised regarding the differences between authorship of Ho et al. and those individuals who are inventors of the present application.

1.4. 35 U.S.C. § 103

The Examiner continues to assert that the Appendix 1 has an "issue date" without presenting any evidence for his assertion.

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Applicants have already respectfully requested, in our last Amendment, that the Examiner specifically state his basis for this assertion. However, the only "evidence" presented by the Examiner is the fact that the Appendix 1 does not specifically state, on its face, that it is proprietary or confidential.

Patent applications are always filed with the USPTO without any specific statement, on their face, that they are proprietary or confidential. Nevertheless, it is USPTO policy to treat patent applications as confidential filings, until issued or published.

The Examiner has presented no evidence to support a position that the Appendix 1 should be treated, for purposes of confidentiality, as being different than any other U.S. patent application.

Evidence, on the face of Appendix 1, that supports it being treated as an ordinary confidential USPTO patent application filing, include the following. Appendix 1 is not formatted as an article or other publication. The title of Appendix 1, on page 2, states it is a "Design and Maintenance Specification." A technical article, intended for publication, could not bear this type of title. Applicants also refer the Examiner to section 1.2 of Appendix 1, which is on its fourth page, entitled "Intended Audience." Applicants note that section 1.2 states: "The intended audience is technical engineering staff which are actively involved in CTG development." Clearly, this is a statement, on the face of the Appendix 1, that it is a company internal engineering document.

If the Examiner wishes to continue to treat Appendix 1 as a publication, applicants respectfully request that the Examiner present some evidence for such position. For example, applicants refer the Examiner to MPEP § 2128 for case law on what constitutes a "printed publication." MPEP § 2128 states (emphasis added):

A reference is proven to be a "printed publication" "upon a satisfactory showing that such document has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it." *In re Wyer*, 655 F.2d 221, 210 USPQ 790 (CCPA 1981)(quoting *I.C.E. Corp. v. Armco Steel Corp.*, 250 F. Supp. 738, 743, 148 USPQ 537, 540 (SDNY 1966))

Since the Examiner has not presented prior art as a basis for the § 103 rejections (i.e., neither Appendix 3, also known as Ho et al., is prior art, nor is Appendix 1, also known as the Harer "reference," prior art), applicants respectfully traverse such rejections.

2. Section II

2.1. Non-Compliant Amendment 37 CFR 1.121

The Examiner formally withdrew this determination in an Office Communication

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mailed August 9, 2005.

2.2. Claim Rejections - 35 U.S.C. § 112 ¶ 1

The Examiner has rejected the claims under § 112 ¶ 1 for the following reason:
"Specification doesn't specifically state user's decision of the goal state condition."

Applicants respectfully disagree and refer the Examiner to page 32 lines 10-12 which state: "To generate a sequence of input vectors suitable for driving the DUT into each of a defined set of goal states, a user first defines a DUT model, a model environment, and a set of design goal states." Applicants respectfully submit that the Examiner's rejection has been traversed.

2.3. Claim Rejections - 35 U.S.C. § 102

As stated above, in section 1.2 of the Remarks, since the Examiner has not presented prior art as a basis for the § 102 rejections (i.e., Ho et al., also known as Appendix 3, is not prior art), applicants respectfully traverse such rejections.

2.4. Claim Rejections - 35 U.S.C. § 103

As stated above, in section 1.4 of the Remarks, since the Examiner has not presented prior art as a basis for the § 103 rejections (i.e., neither Appendix 3, also known as Ho et al., is prior art, nor is Appendix 1, also known as the Harer "reference," prior art), applicants respectfully traverse such rejections.

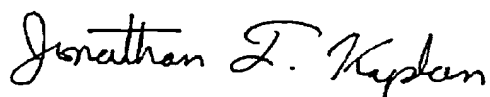
3. Summary

Applicants respectfully submit all objections, rejections and requirements have been fully responded to and request a Notice of Allowance.

The U.S. Patent and Trademark Office is authorized to charge any fee deficiency, or credit any overpayment, to Deposit Account No. 502584 referencing docket number 06816.0173.

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Respectfully submitted,

A handwritten signature in black ink that reads "Jonathan T. Kaplan". The signature is written in a cursive style with a large, stylized 'J' and 'K'.

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